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Joel H. Bock
Cook, Alex, McFarron, Manzo,
Cummings & Mehler, Ltd.
200 West Adams Street - Suite 2850
Chicago, IL 60606

EXAMINER

RIVELL, JOHN A

ART UNIT	PAPER NUMBER
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3753

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,294

Applicant(s)

MARCICHOW ET AL.

Examiner

John Rivell

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/21/07 (Req. for Recon.).
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 16-28 is/are allowed.
6) ☒ Claim(s) 1-7,9-11 and 13 is/are rejected.
7) ☒ Claim(s) 8,12,14 and 15 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments filed February 21, 2007 have been fully considered but they are not persuasive. No amendments to the claims were made.

Claims 1-28 remain pending. Claims 29-36 have been canceled.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 6, 7 and 13 are rejected under 35 U.S.C. §102 (b) as being anticipated by Erickson.

The patent to Erickson discloses a "fluid flow control device of the type having a body (1), a fluid flow path defined in the body including an inlet (at 2), an outlet (60), and a valve seat (25) between the inlet and outlet, and a valve member (24) selectably movable in and out of engagement with the valve seat (25), the improvement comprising a filtering seal disposable in the fluid flow path upstream of the valve seat, the filtering seal comprising: a base member (generally at inlet fitting 3) which defines an inlet (at threaded portion 8) in fluid communication with the flow path's inlet (2), an outlet in fluid communication with the valve seat (25), and an axis between the base member's inlet and outlet; an axial retainer surface (read at left facing surface of flange 10 supporting screen 13) formed on the base member; a radial sealing surface (read at left facing radial sealing surface of flange 4 contacting seal 5) formed on the base member (3) and being engageable with the inlet (2) of the control device body (1); and a screen (13) mounted on the base member (3) in engagement with the retainer surface

(flange 10), the radial sealing surface (4) being radially spaced from the screen (13) a sufficient distance such that compression of the radial sealing surface (4) will not compress the screen (13)" as recited.

Regarding claim 3, in Erickson, "the base member (3) defines at its inlet (to threaded portion 8) a radial end face" as recited. Alternatively, the inlet 8 facing planar annular face of shoulder 9 or the planar annular face of the shoulder 9 that faces the screen 13 provides a "radial end face".

Regarding claim 5, in Erickson, "the base member (3) includes an axially-extending holder flange (10), with the axial retainer surface (left facing face) being defined on said holder flange (10)" as recited.

Regarding claim 6, in Erickson, "the base member (3) includes a radially-extending sealing flange (4), with the radial sealing surface being defined on said sealing flange (4)" as recited.

Regarding claim 7, in Erickson, "the base member (3) defines at its inlet a radial end face (at flange 4) and the sealing flange (the sealing portion of flange 4) has an end face which is coplanar with the end face (at 4) of the base member" as recited.

Regarding claim 13, in Erickson, "the base member (3) has an annular shape" as recited.

Response to Arguments

In response to applicants remarks concerning the above, the argument that:

"the screen (of Erickson) is not mounted (emphasis in original) on the 'inlet adapter' as suggested by the Office Action because the 'inlet adapter' can be removed separately from the screen as stated (in Erickson)"

is unpersuasive in view of the reasons applicant specifies for this argument and the breadth and scope of the term "mounted".

In view of applicants reasons, i.e. the screen of Erickson can be removed from the adapter 3, for the above argument, it is clear that applicant has conferred meaning to the term "mounted" in terms of elements being fixed or not fixed to another element, improperly taken from the application's specification. While it is certainly understood that when one element is fixedly attached to another element so as to not be removable therefrom the one element is "mounted on" the another element. However, when one element is removably fixed to another element so as to be removable therefrom, the one element is also "mounted on" the another element. Absent any qualifying language, "mounted on" is not limited to an association of elements fixed to each other.

As for the remaining dependent claims, applicant relies on the inability of Erickson to include a screen "mounted on" the adapter of independent claim 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson in view of Hendrix.

The patent to Erickson discloses all the claimed features with the exception of having a plurality of locator members attached to the base member and engageable with the inlet of the control device body.

The patent to Hendrix discloses that it is known in the art to employ a plurality of filter element locating devices including pin 66 and tabs 54 for the purpose of properly locating and aligning the filter element 20 in its proper assembled location.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Erickson a plurality of locating elements on the filter mounting element 3 for the purpose of properly locating and aligning the filter element in its assembled location as recognized by Hendrix.

Regarding claim 4, as suggested by either pin 61 of tab 54, the device if the combination would include "at least one boss protruding from the end face" as recited.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the secondary reference to Hendrix contains both the missing structure of the claim as well as the

motivation to modify the device of Erickson. For example, as noted above, the patent to Hendrix discloses that it is known in the art to employ a plurality of filter element locating devices including pin 66 and tabs 54 for the purpose of properly locating and aligning the filter element 20 in its proper assembled location. The motivation, i.e. to properly locate and align the filter element in its proper assembled location is the desired result of the utilization of the pin and tab taught by Hendrix. Such motivation need not be located within the confines of Erickson for propriety. Had the reference to Erickson included such motivation, then Erickson would have potentially anticipated the claim language. Additionally, there is no requirement that the statement of rejection explain in detail how the secondary references teaching could be incorporated into the device of the primary reference. Such physical incorporation of the reference teachings is not the requirement under 35 USC 103. However, for example, as taught by Hendrix, one need only add to Erickson an alignment pin extending from the fixed valve body at 15 mating with a tab in the "adapter" to which the screen 13 is mounted to properly align the screen in its assembled location as taught by Hendrix. Further, there is no requirement in the statement of rejection of addressing an "expectation of success". However, for example, as it is expected to succeed in the device of Hendrix to properly locate the screen element therein, there is also the same level of expectation of success in attempting to properly locate the screen of Erickson by inclusion of alignment pins as taught by Hendrix. Lastly, applicant relies on the inability of Erickson to include a screen "mounted on" the adapter of independent claim 1. As responded to above, Erickson is considered to include the "mounted on" feature recited in the claim.

Further, as it concerns claim 4, applicant argues that the proposed combination fails to include all the claimed structure, namely the "radial end face" of intermediate claim 3.

As set forth above, in the patent to Erickson, within the "base member" 3, there is located a "radial end face". Such a "radial end face" is read on the end face of the bore at the end of the internal threads where the last thread meets the bore. Alternatively, the inlet 8 facing planar annular face of shoulder 9 or the planar annular face of the shoulder 9 that faces the screen 13 provides a "radial end face".

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson in view of Jardin.

The patent to Erickson discloses all the claimed features with the exception of having "a plurality of legs attached to the base member and extending therefrom, and a screen support member attached to the legs".

The patent to Jardin discloses that it is known in the art to employ a filter support member generally at cartridge 4, including a plurality of individual "legs" 8 supporting a filter element, generally at 11, from within the filter element for the purpose of preventing the filter element from collapsing.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Erickson a plurality of legs extending from base member 3, supporting filter element 13 from within the filter element for the purpose of preventing the filter element from collapsing as recognized by Jardin.

Regarding claim 10, in Erickson, as modified, "the screen support member (3 and the internally extending legs thereof taught by Jardin) further comprises an axial retainer surface (at flange 10) in engagement with the screen (13), and a body sealing surface (at flange 4) engageable with the control device body (1)" as recited.

Regarding claim 11, in Erickson, "the body sealing surface (at flange 4) is arranged axially on the screen support member" 3 as recited.

Response to Arguments

In response to applicant's repeated argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the secondary reference to Jardin, as noted above, discloses that it is known in the art to employ a filter support member generally at cartridge 4, including a plurality of individual "legs" 8 supporting a filter element, generally at 11, from within the filter element for the purpose of preventing the filter element from collapsing.

Applicant further argues that one of ordinary skill would not be so inclined to modify Erickson as the flow of fluid from the inlet to the outlet, from inside the screen to the outside of the screen, would preclude the possibility of collapse of the screen. While it is agreed that fluid flow from inside the screen to the outside of the screen of Erickson would not cause collapse of the screen, any pressure difference across the screen, from the outside diameter of the screen to the inside diameter of the screen would potentially

cause the screen to collapse. Such as potential pressure differential is certainly possible as the system upstream of the valve device may experience certain conditions in which a backpressure may be applied to the valve device causing a pressure differential across the screen would tend to collapse the screen. Conversely, should the valve element fail for some reason causing the valve to slam closed then a back pressure wave would be generated within the valve body traveling backwards towards the inlet placing a pressure differential across the filter element in a direction tending to collapse the filter element. Certainly, having structure added to the screen, in an attempt to preclude collapse of the screen would be beneficial in those instances where such a collapse is possible.

Claims 16-28 are allowed.

Claims 8, 12 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (571) 272-4918. The examiner can normally be reached on Mon.-Thur. from 6:30am-5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Rivell
Primary Examiner
Art Unit 3753

j.r.